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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/535,550	03/27/2000	Jorge A. Morando	MJV-120-A	3595

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EXAMINER

IP, SIKYIN

ART UNIT PAPER NUMBER

1742

DATE MAILED: 05/22/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

MF/10

Office Action Summary	Application No.	Applicant(s)	
	Examiner	Group Art Unit	

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 1/14/02; 3/13/02; 4/8/02
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 2-29, 34 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 2-29, 34 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 7
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

DETAILED ACTION

Double Patenting

1. The terminal disclaimer filed on April 8, 2002 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of USP 6004507 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
3. Claim 28 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 63274740, JP 09049051, JP 11293410, or JP 08325673 (see their abstracts).

Claim Rejections - 35 USC § 103

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating

obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 2-27, 29, and 34 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 09049051.

7. Claims 2, 4-7, 10-27, 29, and 34 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 08325673.

8. Claims 2-4, 6-13, 16-27, 29, and 34 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 63274740.

9. Claims 2-9, 14-27, 29, and 34 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 11293410.

10. The cited reference(s) disclose(s) the features including the claimed component of equipment and its compositions. The features relied upon described above can be found in the reference(s) at: their abstracts. The difference between the reference(s) and the claims are as follows: The cited references do not disclose the recited intended use. But, the claimed intended use of the claimed alloy does not lend patentability to the alloy. A mere statement of a new use for an otherwise old or obvious composition

cannot render a claim to the composition patentable. See *In re Lemin*, 51 CCPA 942, 326 F.2d 437, 140 USPQ 273 (1964), *Kropa v. Robie*, and *Mahlman*, 88 USPQ 478 (CCPA 1951). Moreover, an intended use clause found in the preamble of an apparatus/product claim is not afforded the effect of a distinguishing limitation unless the body of the claim sets forth structure which refers back to, is defined by, or otherwise draws life and breath from the preamble. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *Kropa V. Robie*, 88 USPQ 478 (CCPA 1951).

11. With respect to the claim 29 that the component such as pumping member, post, or shaft reads on products of cited references.

12. The limitation in claim 34 is material property which would have been inherently possessed by the materials of cited references.

Response to Arguments

13. Applicant's arguments filed February 13, 2002 have been fully considered but they are not persuasive.

14. In view of applicants' instant remarks that claims 5 and 14-15 rejected by JP 63274740, claims 10-12 rejected by JP 11293410, and claims 3 and 8-9 rejected by JP 08325673 have been withdrawn.

15. Applicants argue that the cited references do not disclose the claimed intended

use of the component. But, the claimed intended use of the claimed alloy does not lend patentability to the alloy. A mere statement of a new use for an otherwise old or obvious composition cannot render a claim to the composition patentable. See *In re Lemin*, 51 CCPA 942, 326 F.2d 437, 140 USPQ 273 (1964), *Kropa v. Robie*, and *Mahlman*, 88 USPQ 478 (CCPA 1951). Moreover, an intended use clause found in the preamble of an apparatus/product claim is not afforded the effect of a distinguishing limitation unless the body of the claim sets forth structure which refers back to, is defined by, or otherwise draws life and breath from the preamble. In *re Casey*, 152 USPQ 235 (CCPA 1967) and *Kropa V. Robie*, 88 USPQ 478 (CCPA 1951).

16. Applicants' argument in paragraph bridging pages 3 and 4 of the instant remarks is noted. But, the different intended use does not make the old product novel.

17. Applicants' argument in page 4, first full paragraph of the remarks is noted. But, applicants fail to point out what claimed limitation has not been met by the cited references.

18. Applicants argue that JP 63274740 fails to disclose B as set forth in claim 4 (0.15-0.5 wt.%), and P as set forth in claim 7 (less than about 0.005 wt.%). But, the abstract of said reference discloses 0.5-2.5 wt.% B. The claimed 0.5 wt.% B is

anticipated by cited reference. The abstract of said reference discloses P less or equal to 0.05 wt.% P which overlaps the claimed less than 0.005 wt.% P.

19. Applicants argue that JP 08325673 fails to teach the S in claim 28, P in claim 28, less than about 1 wt.% Si in claim 10, 1.5-3 wt.% V in claim 16, 2-4 wt.% Nb in claim 18, and less than about 1.5 wt.% Ta in claim 22. But, said reference in abstract discloses 3-8 wt.% V and 0.1-2 wt.% Nb which are anticipated the claimed 3 wt.% V and 2 wt.% Nb in said claims. With respect to the claimed contents of elements S, P, Si, and Ta which include zero. Thus, cited reference does not require to recite said elements.

20. Applicants argue that JP 11293410 fails to teach the less than about 0.005 wt.% S in claim 6, less than about 0.005 wt.% P in claim 7, 2-4 wt.% Nb in claim 18, 3-5 wt.% Co in claim 20, and less than about 1.5 wt.% Ta in claim 22. The S, P, and Ta contents in claims 6, 7, and 22 respectively read on zero which suggests said elements could be eliminated from claims. JP 11293410 in abstract discloses 0.03-2 wt.% Nb and less or equal 3 wt.% Co which are anticipated the claimed 2 wt.% Nb and 3 wt.% Co.

Conclusion

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is

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filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06 (a) and 37 C.F.R. § 1.119.

Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (703)-308-1146.

The facsimile phone number for this Art Unit 1742 are (703) 305-3601 (Official Paper only) and (703) 305-7719 (Unofficial Paper only). When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.



SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742

S. Ip
May 20, 2002